

Serial No. 09/595,865

Atty. Docket No. RD28052

REMARKS

By way of this amendment, claims 1, 2, 12, 19, 20, 24 and 27 have been amended. Claims 1-28 are currently pending in the application. Applicant hereby requests further examination and reconsideration in view of the following remarks.

The Examiner has rejected claims 1, 3-19 and 21-28 under 35 U.S.C. § 102(e) as being anticipated by Hutsch et al. This ground of rejection is respectfully traversed.

As applicant has previously argued, Hutsch et al fails to anticipate each of independent claims 1, 12, 19 and 27. Specifically, Hutsch et al does not describe a means for, or step of, creating a decision tree as required by the independent claims. The Examiner contends that Hutsch et al describes the claimed means for creating a decision tree in paragraph [0029]. However, paragraph [0029] merely discusses a profiling service and a profiling service configuration file that includes a decision tree wherein the decision tree performs actions. Paragraphs [0237] and [0257] of Hutsch et al further describe that the profiling service analyzes a client request and decides the templates, JSP pages, servlets or Beans to be used by applying the decision tree. As such, Hutsch et al merely describes using an existing decision tree. Nothing in Hutsch et al suggests actually creating a decision tree or providing a means for creating a decision tree, as required by the independent claims.

Moreover, each one of the independent claims has been amended to recite that the created decision tree represents a decision making process for which a process advisor application is to be developed. While applicant has previously argued that Hutsch et al does not describe creating a decision tree, it is respectfully submitted that Hutsch et al clearly does not disclose creating or even using a decision tree that represents a decision making process for which a process advisor application is to be developed. As described on page 3 of the

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present application, a "processor advisor application" refers to an application that is a specific type of expert system that simulates the knowledge, judgment and experience in a decision making process of one or more persons. Hutsch et al, which involves a network portal system, does not involve a processor advisor application.

Applicant also repeats the previously submitted argument that Hutsch et al fails to disclose the claimed means and step of compiling the decision tree into a data file. The Examiner contends that Hutsch et al discloses the step of, and means for, compiling the decision tree into a data file in paragraphs [0106] and [0637]. Applicant respectfully disagrees. While paragraph [0106] does mention a compiler, there is no indication that the compiler compiles the decision tree of the profiling service configuration file. The present independent claims require that the decision tree be compiled. Paragraph [0637] simply does not discuss compiling a decision tree into a data file.

Applicant further submits that Hutsch et al fails to disclose the claimed means and step of converting the data file into one or more computer viewable documents. The Examiner contends that Hutsch et al discloses the step of, and means for, converting the data file into one or more computer viewable documents in paragraph [0086]. Paragraph [0086] describes an out-of-office user using the network portal system of Hutsch et al to review an e-mailed document with a PDA. While this would presumably entail converting some data into a "computer viewable document," there is no indication in Hutsch et al that a data file that has been compiled from a decision tree is converted into a computer viewable document.

Accordingly, applicant respectfully submits that Hutsch et al fails to disclose creating a decision tree, particularly a decision tree that represents a decision making process for which a process advisor application is to be

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developed; compiling the decision tree into a data file; and converting the data file into one or more computer viewable documents. In response to this argument, the Examiner cites paragraph [0266] of Hutsch et al, which discusses a pseudo code representation of an actual XML decision tree. The Examiner asserts that this passage leads to the conclusion that a program code representing a logical entity has to be compiled to implement and interface with the application. However, even assuming for the sake of argument that this passage teaches compiling the decision tree into a data file, Hutsch et al still fails to suggest creating a decision tree (as opposed to merely using an existing decision tree) and converting a data file into one or more computer viewable documents. In responding to applicant's prior arguments, the Examiner has focused on one aspect of the invention (the compiling feature) and not addressed the other features.

For all of the reasons set forth above, it is respectfully submitted that Hutsch et al fails to anticipate independent claims 1, 12, 19 and 27. Claims 3-11, 13-18, 21-26 and 28 depend from independent claims 1, 12, 19 and 27 and are thus believed to be allowable for the reasons set forth above.

The Examiner has rejected claims 2 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Hutsch et al. This ground of rejection is respectfully traversed.

The Examiner recognizes that Hutsch et al does not disclose using an off-the-shelf process mapping program but asserts that it would have been obvious to do so, taking "Official Notice" that an off-the-shelf process mapping program is old and well known. Both claims 2 and 20, as amended, recite using an off-the-shelf process mapping program having a palette that displays a large number of predefined shape icons representing certain decision tree objects and a dynamic grid display onto which an operator may place selected ones of the shape icons. Applicant submits that it would not have been obvious to use such

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a process mapping program to create a decision tree, when considering the claims as a whole. Furthermore, while not conceding that using an off-the-shelf process mapping program would have been obvious in the claimed system and method, applicant respectfully submits that Hutsch et al would not render the claims unpatentable even if it were obvious to use an off-the-shelf process mapping program. This is because there would still not be any suggestion of creating a decision tree; compiling the decision tree into a data file; and converting the data file into one or more computer viewable documents. In other words, Hutsch et al, even when modified in the manner set forth by the Examiner, would still fail to teach or suggest the requirements of independent claims 1 and 19.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration of the objections and rejections is requested. Allowance of claims 1-28 at an early date is solicited.

Respectfully submitted,

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Date

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